

PATENT COOPERATION TREATY

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From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

WRITTEN OPINION
(PCT Rule 66)

To:

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18-02-2004

Date of mailing (day/month/year)	16.02.2004 16.5.04 pas
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Applicant's or agent's file reference BP106601 /JJA /RKO	REPLY DUE within 3 month(s) from the above date of mailing
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International application No. PCT/FI 03/00445	International filing date (day/month/year) 05.06.2003	Priority date (day/month/year) 06.06.2002
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International Patent Classification (IPC) or both national classification and IPC D21G1/00

Applicant METSO PAPER, INC. et al.


- This written opinion is the **first** drawn up by this International Preliminary Examining Authority.
- This opinion contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☐ Certain documents cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application
- The applicant is hereby **invited to reply** to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.
- The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 06.10.2004

Name and mailing address of the international preliminary examining authority:	Authorized Officer
 European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Bichi, M Formalities officer (incl. extension of time limits) Abadie, N Telephone No. +49 89 2399-2746



I. Basis of the opinion

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

Description, Pages

1-10 as originally filed

Claims, Numbers

1-8 as originally filed

Drawings, Sheets

1/2-2/2 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

5. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

6. Additional observations, if necessary:

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**1. Statement**

Novelty (N)	Claims	1 No
Inventive step (IS)	Claims	1-8 No
Industrial applicability (IA)	Claims	

2. Citations and explanations**see separate sheet**

- 1). The following documents (D) are referred to in this communication; the numbering will be adhered to in the rest of the procedure.

D1 = US-A-6129011

D2 = US-A-4736678

D3 = US-A-4389933

D4 = US-A-4597275

D5= EP-A-0735185 (not cited in the Search Report)

- 2). The subject-matter of claim 1 is not throughout clear, thus not satisfying the requirements of Art. 6 PCT as follows:
- in lines 13-18 is disclosed that the nips are closed by moving the first roll/second roll. In reality the **castings of said rolls and not the rolls themselves are moved**. This should be explicitly disclosed.
 - "each set of rolls has at least three rolls". In case of only three rolls, "the other intermediate rolls" (see line 10) are not present. This also should be clarified, for example disclosing "and in case further intermediate rolls are present, said further intermediate rolls being provided...etc."
 - the several set of rolls are attached to one or several **frames** (see claim 1, lines 2 and 3). This should be present also in line 9. Concerning this feature, claim 3 is not consistent with claim 1 (see the presence of "and/or" and also unclear, since it repeats features already present in claim 1 ("fixedly attached to the calendar frame")).
- 3). The prior art already discloses arrangements which are very similar to the one claimed. In particular D1, D2 and D5 all disclose **an intermediate roll which is fixedly attached to the frame**, so that the load on the upper stack of rolls can be different from the load of the lower stack. In particular according to D5 (see for example col.4, lines 40-47; col.5, lines 33-37; claim 12) the first, second and intermediate roll are "fixedly attached" to the frame, however they can move having regard to the frame ("fixedly attached" is a very unclear wording; what should exactly and clearly mean?? see Art.6 PCT). Apparently the present application, instead of moving the "entire" first and/or second and/or intermediate roll as in D2, moves only the **casing** of the first and second rolls, while the intermediate roll does not move at all.

However the fact of **moving the casing(s)** would appear to be essentially already known from D5(see passages quoted above, i.e. claim 12; note that on col. 5 at least

the first upper roll is "ortsfest gelagert", i.e. clearly fixedly attached).

The subject-matter of claim 1 would thus appear to be already known from D5 and is therefore not new. Claim 1 therefore would not appear to meet the requirements of Article 33(2) PCT.

- 4). The applicant may object that in any case in D5 there is **also** an hydraulic cylinder 29 (see col.5, lines 3-15) moving the roll in the vertical direction. No inventive step can however be recognized in the fact of simply eliminating such cylinder and realizing the nip closing **only through the movement of the casings**. For example D3 already explicitly discloses a nip closing **by both adding steps of the movement of an hydraulic cylinder and a casing displacement** (see in particular col.8, lines 5-20 and figure 1). It would appear to lie well within the normal capacities of the skilled engineer to conceive a fixed lower roll with a moving casing (it is clearly stated in claim 12 that also the lower roll can have a moving casing). **This is just a possibility out of three** (first: see D2; second: D5; third: the present application) the effects of which are throughout foreseeable, especially in the light of the problem posed. No inventive step can be herein recognized.

The subject-matter of claim 1 therefore does not appear to involve an inventive step (Art. 33(3) PCT).

- 5). The dependent claims do not appear to contain any additional features which, in combination with the features of any claim to which they refer, involve an inventive step. The features herein disclosed would appear to be merely some of several constructional possibilities from which the skilled man would select, in accordance with circumstances, without the exercise of inventive skill. Hints thereto could furthermore easily be taken from the above mentioned documents D1-D5, all strictly related to the field.

- 6). It is thus fully unclear which should be the gist of the invention and which features of the application could form the basis for a new independent claim satisfying the requirements of Articles 33(2) and (3) PCT.

Should the Applicant regard some particular matter as new and inventive, an independent claim including such particular matter should be filed taking account of Rule 6.3 PCT. Any new independent claim should be drafted in the two-part form, bearing in mind that all the features known from document D5 should be placed in the preamble of such a claim.

The applicant should also indicate in the letter of reply the difference vis à vis the state of the art, in particular D5, and the significance thereof.

The characterising portion of any new ind. claim should be clear and include all the essential features of the invention (see point 2 above).

- 7). To meet the requirements of Rule 5(a)(ii) PCT, the documents D2, D3 and D5 should also be identified in the description and the relevant background art disclosed therein should be briefly discussed.

- 8). In case new claims are filed, the description as well as the dependent claims must be brought into conformity with the new claims; care should be taken during revision not to add subject-matter which extends beyond the content of the application as originally filed (for example through deletion of features) Article 34 (2)(b) PCT.

The applicant is requested to file amendments by way of replacement pages in the manner stipulated by Rule 66.8(a) PCT. In particular, fair copies of the amendments should be filed preferably in triplicate.

In order to facilitate the examination of the conformity of the amended application with the requirements of Article 34 (2)(b) PCT, the applicant is requested to clearly identify the amendments carried out, irrespective of whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based.

If the applicant regards it as appropriate these indications could be submitted in handwritten form on a copy of the relevant parts of the application as filed.

Any handwritten amendment should be clearly readable and set back from the margins of the sheet.